

Application No.: 10/087,127

4

Docket No.: 488422000600

REMARKS

Reconsideration is respectfully requested in view of the following remarks. Claims 1-32 were pending in this application. By virtue of this response, claims 4-6 and 13-32 have been cancelled as being drawn to non-elected inventions. Accordingly, claims 1-3 and 7-12 are currently under consideration.

Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

CLAIM REJECTIONSRejection Under 35 U.S.C. 102(e)

Claims 1-3 and 7-11 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by McIntosh et al. (U.S. 6,679,909). Specifically, the Office Action states in part that "McIntosh et al. disclose in Figs. 4-6, a stent delivery system having the limitations of claims 1-3, including: an elongate wire (70), a radially expandable stent (60) positioned on the wire towards the distal end, where a tubular sheath member (24) covers at least a portion of the wire.

Applicants submit that McIntosh et al. is an improper reference under Section 102 because it does not teach a stent positioned on a wire, as alleged by the Examiner, and as required by claims 1-3 and 7-11. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). McIntosh et al. do disclose a stent and a wire, but the stent (60) is configured to lie on flexible member (58), not on wire (70) (see Figs. 1 and 4). As shown in Fig. 4, wire (70) is positioned within a guide wire lumen (40) of inner catheter (22), and is no where near stent (60). Accordingly, McIntosh et al. does not describe all the claim limitations as required under Section 102.

Withdrawal of the rejection is respectfully requested.

pa-917065

Application No.: 10/087,127

5

Docket No.: 488422000600

Under 35 U.S.C. 103(a)

Claim 12 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over McIntosh et al. in view of Gould et al. (4,586,923). Specifically, the Office Action states that it would have been obvious to one of ordinary skill to modify the stent delivery system of McIntosh et al. by adding the flush port taught by Gould et al. in order to advantageously attach other medical devices.

Applicants disagree that the combined teachings of McIntosh et al. and Gould et al. support a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that when combined, the cited references must teach or suggest all the claim limitations." See MPEP 2143. As discussed above, McIntosh et al. does not teach a stent positioned on a wire, as required by the claim 12. Gould et al. does not cure this defect.

Withdrawal of the rejection is respectfully requested.

pa-917065

Application No.: 10/087,127

6

Docket No.: 488422000600

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 488422000600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 29, 2004

Respectfully submitted,

By 
Lisa A. Amii

Registration No.: 48,199
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5674

pa-917065